

REMARKS

Claims 1-10 are pending and stand ready for further action in the merits. In the present amendment, the title has been amended based on a request of the Examiner at page 2 of the outstanding office action (*see paragraph no. "4."*), and the abstract of the invention has been amended based on a request of the Examiner at page 3 of the outstanding office action (*see paragraph no. "5."*). No new matter has been added by the above-amendment.

The above-amendment does not narrow the scope of the invention and/or has not been made for the sake of patentability.

Specification

The Examiner has requested that the title of the invention be amended, and the Examiner has also requested that the abstract be amended to be a single paragraph of 50-150 words and to avoid legal phraseology, and the like.

In reply to the Examiner's request, the applicants have amended both the title of the invention and the abstract as requested. As such, reconsideration of the comments set forth at pages 2-3 of the outstanding office action in paragraphs "4." and "5." is respectfully requested at present.

Claim Rejection Under 35 USC § 103 (Claims 1 and 3-10)

Claims 1 and 3-10 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Kobayashi et al. (US 6,284,361) in view of Eichorst (US 5,726,001),

Yamaguchi et al. (US 4,617,226) and Zinbo (US 6,312,796). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

Firstly, the technical field of Eichorst (imaging elements) is different from that of the present invention (magnetic tapes). Therefore, there would have been no motivation to combine the disclosure and teaching of Eichorst with that of Kobayashi et al. Moreover, it is submitted that the USPTO’s asserted combination of Eichorst with Kobayashi merely results from an

improper application of hindsight reconstruction on the Examiner's part, when considering the patentability of the instant invention. Such improper reliance on "hindsight reconstruction" was addressed by the Court of Appeals for the Federal Circuit in the case of In re Dembiczak 50 USPQ2d 1614, 1616 (Fed. Cir. 1999), wherein the court states as follows:

*Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.**

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Frisch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also Graham, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to

obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See , e.g. , Interconnect Planning Corp. v. Feil , 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). ...

Apart from the above considerations, even if the disclosure of Eichorst is combined with that of Kobayashi, any resulting magnetic tape obtained by such a combination would have an intermediate layer, which only enhances the adhesion between a magnetic layer and a lower layer. Neither Eichorst nor Kobayashi teach how to suppress interfacial fluctuation at an interface between an upper magnetic layer and a lower non-magnetic layer.

For example, while Kobayashi uses "an intermediate layer" the intermediate layer of Kobayashi is different from the intermediate binder layer of the present invention. Unlike the present invention, the intermediate layer of Kobayashi simply corresponds to a lower non-magnetic layer.

Based on such considerations, it is submitted that the instant invention is in no way rendered obvious by the combined disclosures of Kobayashi in view of Eichorst.

Likewise, because the remaining cited art references of Yamaguchi et al. and Zinbo do not cure the deficiencies of the Kobayashi or Eichorst references, it also follows that any combination of the disclosures of Yamaguchi et al. and Zinbo with those of Kobayashi or Eichorst, would not result in the instant invention as claimed or otherwise allow one of ordinary skill in the art to arrive at the instant invention as claimed.

Further to the above, it is noted that Yamaguchi et al. is simply relied on by the USPTO for teachings that are similar to Eichorst (*see page 4, last paragraph of the office action*), and

Zinbo is simply relied upon for its teachings regarding a “squareness ratio” (SR) and “Br” values (*see page 6, second full paragraph, and page 7, first paragraph of the office action*).

Accordingly, reconsideration and withdraw of the outstanding rejection of claims 1 and 3-10 is respectfully requested at present.

Claim Rejection Under 35 USC §103 (Claim 2)

Claim 2 has been rejected under the provisions of 35 USC § 103(a) as being unpatentable over Kobayashi et al. (US 6,284,361) in view of Eichorst (US 5,726,001), Yamaguchi et al. (US 4,617,226) and Zinbo (US 6,312,796), further in view of Kolb et al. (US 6,7333,906). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Distinctions Over the Cited Art

The deficiencies of the cited Kobayashi et al., Eichorst, Yamaguchi et al. and Zinbo references are noted above, and the addition of the Kolb et al. disclosure does not cure such deficiencies. Particularly, it is noted that the cited Kolb et al. disclosure is simply being relied on for an assertion that one can regulate the rheological properties of deposited layers in order to insure minimizing fluctuations at the interface of a magnetic layer and a prior deposited layer, which leads to improved recording performance (*see page 8, third paragraph of the outstanding office action*).

As such, it again follows that one of ordinary skill in the art, upon considering the disclosures of the cited art references of record would in no way be motivated to arrive at the

instant invention as claimed, even upon considering the combined disclosures of Kobayashi et al., Yamaguchi et al., Zinbo, and Kolb et al. As such, the outstanding 35 USC § 103(a) rejection of claim 2 is not sustainable and must be withdrawn.

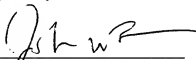
CONCLUSION

Based on the amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of allowance indicating that each of pending claims 1-10 is allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number set forth below, to conduct an interview in an effort to expedite further prosecution in connection with the present application.

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Respectfully submitted,

By 

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